

REMARKS

- 1) The Examiner's withdrawals of the previous rejections recited in the Office Action are noted with appreciation.
- 2) Applicants provide herewith an updated PTO-1449 citing 3 references, and the corresponding fee under 37 C.F.R. 1.17 (p). A machine translation of the foreign reference is provided as well.
- 3) Applicants have amended claim 1 as shown above, to now require that the second doping element consists essentially of gallium. Support for gallium as a preferred second doping element can be found in the specification at page 6, lines 11-14. Claim 4 has been cancelled accordingly. In addition, claims 5-8 have been amended to provide further embodiments wherein the second doping element further consists essentially of palladium, gold, copper, or indium, respectively, in addition to gallium. Support for these amendments can be found in the specification at page 6, lines 1-10.
- 4) The Examiner has rejected claims 1, 4-8, and 11 under 35 U.S.C. 103 over Ohno. It should be noted that claim 4 has been cancelled. Regarding the remaining claims, Applicants respectfully assert that this ground of rejection has been overcome by the instant amendment.

Ohno relates to an optical recording medium having several layers, including a semi-transparent layer, an inter-diffusion protection layer, a first protective layer, a phase-change recording layer, a second protective layer, and a metallic reflective layer. The metallic reflective layer may comprise Ag, Al, Au or Cu, and may further contain certain impurities. Paragraph [0133] provides a general list of possible materials which may be present in the metallic reflective layer. According to the reference, "The reflective layer may be made of alloys comprising Ag, Al, Au or Cu and up to 10 atom % of impurity elements. The impurity elements include Cr, Mo, Mg, Zr, V, Nb, Hf, Ag, In, Ga, Zn, Sn,

Si, Cu, Au, Al, Pd, Pt, Pb, Cr, Co, Ti, rare earth elements, O, and N. The Examiner asserts that the present claim is obviated by Ohno, stating that since Ohno discloses rare earth elements, that it would have been obvious to use erbium as the rare earth element in a silver alloy of Ohno.

Applicants respectfully submit that this position is incorrect, since Ohno fails to teach or suggest the *specifically required formulations* of the present claims. The mere fact that Ohno broadly discloses the possible use of *any* rare earth element *in general* does not render the presently claimed invention obvious. Ohno clearly *fails* to show the *particular formulation* of the presently claimed alloy consisting essentially of silver as a main element, erbium as a first dopant element, and gallium as a second dopant element. Ohno does not disclose any alloy formulations which simultaneously contain all three of silver, erbium, and gallium, much less an alloy which *consists essentially of* these specific materials.

Applicants respectfully submit that an artisan having common sense at the time of the invention would not have reasonably formulated the particular silver alloys of the presently amended claims, upon a reading of Ohno. Thus, it is respectfully submitted that the 35 U.S.C. 103 rejection has been overcome by the instant amendment.

5) The Examiner next rejects claims 1, 6, 7, and 11 under 35 U.S.C. 103 over JP 2003-113433. Applicants submit that this ground of rejection has also been overcome by the instant amendment.

The present claims have been amended to now require that the silver alloy consists essentially of *silver* as a main element, *erbium* as a first dopant element, and *gallium* as a second dopant element. Such is not taught by JP '433. The present reference provides a silver alloy film which may contain 0.1 – 2% of one or more of Sc, Y, Sm, Eu, Tb, Dy, Er, or Yb; 0.1 – 3% of Cu and/or Au; and the balance substantially Ag. Thus, while it may be possible for the alloy of JP '433 to contain both erbium and silver, *nothing* in this reference provides an embodiment which also contains gallium as presently required.

Furthermore, this reference fails to teach or suggest a single embodiment which consists essentially of silver as a main element, erbium as a first dopant element, and gallium as a second dopant element. It is urged that this particular formulation, which is required by the present claim 1, would not have been contemplated by one of ordinary skill in the art upon a reading of JP'433. Regarding the dependent claims 6, 7, and 11, Applicants submit that while some of the individual additional features of these claims may be otherwise known in the art, these claims all relate to *narrower* embodiments of the invention disclosed in claim 1. It is therefore submitted that where claim 1 is sufficiently inventive in view of the cited art, all claims depending from claim 1 should be considered inventive as well. For all of the above reasons, it is respectfully submitted that the 35 U.S.C. 103 rejection has been overcome by the instant amendment.

The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the Examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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